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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,441	09/16/2003	Finn Myhren	063779-5001	9826
9629 7590 06/10/2009 MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004				
EXAMINER				
BADJO, BARBARA P				
ART UNIT		PAPER NUMBER		
1612				
MAIL DATE		DELIVERY MODE		
06/10/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/662,441

**Applicant(s)**

MYHREN ET AL.

**Examiner**

Barbara P. Badio

**Art Unit**

1612

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 57, 70, 71, 77 and 88 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 57, 70, 71, 77 and 88 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_

**Final Office Action on the Merits of a RCE**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Status of the Application***

2. Claims 57, 70, 71, 77 and 88 are pending in the present application. The instant claims stand rejected as indicated below.

***Duplicate Claims***

3. The objection to claims 60 and 72 under 37 CFR 1.75 as being substantial duplicates of claims 56 and 57, respectively is made moot by the cancellation of the instant claims.

***Claim Objections***

4. The objection to claims 69, 80 and 87 under 37 CFR 1.75(c), as being of improper dependent form is made moot by the cancellation of the instant claims.

***Claim Rejections - 35 USC § 112***

5. The rejection of claims 56, 58-61, 64, 66, 69 and 84 under 35 USC 112, first paragraph is made moot by the cancellation of the instant claims.

**6. The rejection of claims 70 and 71 under 35 USC 112, first paragraph is withdrawn.**

**7. The rejection of claim 66 under 35 USC 112, second paragraph is made moot by the cancellation of the instant claim.**

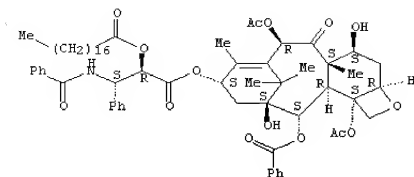
***Claim Rejections - 35 USC § 103***

**8. The rejection of claims 56, 58-61, 64, 66, 69, 72, 73, 80-82, 84, 87 and 89 under 35 USC 103(a) over Mayhew et al. (US 5,580,899) is made moot by the cancellation of the instant claims.**

**9. The rejection of claims 57, 70, 71, 77 and 88 under 35 USC 103(a) over Mayhew et al. (US 5,580,899) is maintained.**

Applicant argues the scope of the genus of compounds taught by the reference. Accordingly, applicant argues the skilled artisan would not have a reason to modify the known compound in a particular manner as recited by the instant claim to achieve therapeutically beneficial levels of a drug in a cell. Applicant's argument was considered but not persuasive for the following reasons.

As stated in the previous Office Action, Mayhew teaches taxane derivatives for use in treating cancers and exemplifies a C18 fatty acid derivative thereof:



. The difference between the exemplified prior art compound and the claimed compound is unsaturation in the 9-position of the exemplified C18 fatty acid. However, the reference teaches the use of saturated or unsaturated, aliphatic or branched fatty acids and, thus, the corresponding unsaturated fatty acids derivatives, such as, oleic and elaidic acids, are rendered obvious.

Applicant argues the skilled artisan would not have a reason to modify the prior art compound in a particular manner as recited by the instant claim to achieve therapeutically beneficial levels of a drug in a cell. However, Mayhew teaches the attachment of a hydrophobic organic moiety stabilizes the association of the taxane derivative with a lipid carrier in the plasma and, thus, provides motivation to make any of the species of the genus of taxane derivative of the reference, including those of the instant claims.

For these reasons and those given in the previous Office Action, the rejection of claims 57, 70, 71, 77 and 88 under 35 USC 103(a) over Mayhew et al. (US 5,580,899) is maintained.

***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Telephone Inquiry***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara P. Badio whose telephone number is 571-272-0609. The examiner can normally be reached on M-F from 6:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on 571-272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Barbara P. Badio/  
Primary Examiner, Art Unit 1612